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Appeal Brief
S. Zimmerman
11/12/02

IN THE UNITED STATES AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
KOTSIPOULOS, Thomas George)
Serial No.: 09/338,158)
Filed: June 22, 1999)
For: COUPON INSERTING APPARATUS)

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APPEAL BRIEF

APPEAL FROM THE FINAL OFFICE ACTION
DATED MARCH 6, 2002

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Dated: November 5, 2002

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**IN THE UNITED STATES AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
KOTSIPOULOS, Thomas George)	
)	
Serial No.: 09/338,158)	Group Art Unit: 3721
)	
Filed: June 22, 1999)	Examiner: Eugene L. Kim
)	
For: COUPON INSERTING APPARATUS)	

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

APPEAL BRIEF

In support of its Notice of Appeal, filed September 5, 2002, and pursuant to 37 C.F.R. § 1.192, Appellant presents in triplicate this Appeal Brief accompanied by a check for \$160.00 to satisfy the fee under 37 C.F.R. § 1.17(c). This is an appeal to the Board of Patent Appeals and Interferences from a decision finally rejecting claims 5-12. The appealed claims are set forth in the attached Appendix A.

If any additional fees are required or if the enclosed payment is insufficient, please charge the deficiencies to our Deposit Account No. 18-1942. If a fee is required for an extension of time under 37 C.F.R. § 1.136 and such fee is not accounted for above, Appellant petitions for such an extension and requests that the fee be charged to the Deposit Account No. 18-1942.

I. Real Party in Interest

The real party in interest is the assignee, Carol Joyce Witt.

II. Related Appeals and Interferences

Appellant knows of no other appeal or interference that will directly affect, be directly affected by, or have a bearing on the decision of the Board of Patent Appeals and Interferences in this appeal.

III. Status of Claims

Claims 5-12 are currently pending on appeal. In the March 6, 2002 Office Action, the Examiner finally rejected claims 5-12 under 35 U.S.C. § 103(a) as unpatentable over Roetter *et al.*, U.S. Patent No. 4,261,497 (hereinafter Roetter) in view of Lewis *et al.*, U.S. Patent No. 4,468,912 (hereinafter Lewis).

Claim 1 has been cancelled and is not pending on appeal. Claims 2-4 have been allowed and also are not currently pending on appeal.

IV. Status of Amendments

Subsequent to the March 6, 2002 Final Office Action, Appellant filed an After Final Action – Response D on May 6, 2002. In this response, Appellant submitted further remarks in support of its argument that the Appellant's invention is not taught by Roetter and Lewis. In the May 30, 2002 Advisory Action, the Examiner maintained the objection in the prior Final Office Action. The pending claims are set forth in the Appendix at Tab A.

V. Summary of Invention

The claimed invention relates to novel apparatus and methods for inserting coupons into containers moving along a high volume handling system, with the terms “coupons”

and “containers” used in their broadest possible senses. (Page 1, lines 16-17; Page 1, line 26 – Page 2, line 4). In particular, the invention separates the forwardmost coupon from a continuous web and inserts the coupon into a container as the container passes a designated location for insertion. (Page 1, lines 16-19).

Prior art coupon dispensing systems suffer various defects not present in the claimed invention. For example, some prior art systems commonly operate using a stack of precut coupons individually dispensed from a downwardly sloping channel and rely on containers being positioned in a particular relationship to the mechanism, resulting in inflexibility in operation. (Page 2, lines 5-12). Other systems require mechanical cutting devices to separate a coupon from a continuous web, which are then dispensed to moving packages on a conveyor system. (Page 2, line 22- Page 3, line 2). These systems are often complex and susceptible to jamming at high operating speeds, resulting in coupons not being placed in every container or multiple coupons inadvertently being placed in one container. (Page 3, lines 3-7). Moreover, many prior art systems are not capable of accommodating variations in spacing between containers, conveyor speeds, and/or changes in location of insertion of size or shape of the container. (Page 3, lines 8-11).

Appellant’s invention provides for the first time a coupon inserting apparatus that overcomes these deficiencies. Specifically, Appellant’s invention ascertains the location of each of a plurality of containers moving at varying speeds and positively places a coupon at that location at a predetermined time. (Page 3, lines 15-18). The claimed invention also provides an apparatus capable of detaching a single coupon from a continuous web at high speed and with precision and inserting it into a container. (Page 3, lines 19-21).

Claims 5 and 7 are claims directed to a method of inserting coupons into food

packaging by bursting the forwardmost coupon from a continuous web with transversely weakened web portions. Claim 5 is more specifically directed towards the method of bursting the forwardmost coupon from the next coupon along the weakened transverse portion and placing the bursted coupon into a food packaging container. Claim 7 is specifically directed to the employment of feed rolls to advance the web to positioning rolls situated downstream in bursting and inserting the coupons.

Claims 6 and 8 incorporate a specific timing signal to determine when the coupon is to be burst. Claim 6 is specifically directed to providing a signal which relates to when the forwardmost coupon is to be burst and inserted into the container. Claim 8 employs a signal that is related to the time at which to burst and insert the coupon using feed and positioning rolls.

Claims 9-12 are apparatus claims directed to Appellant's novel coupon inserting apparatus. Claims 9 and 11 are directed to an apparatus in which the feed rolls and positioning rolls are oriented to define a bight with the coupon for bursting. Claim 10 is directed a burster which includes a coupon advancing apparatus for feeding and a delivery apparatus for bursting and insertion. Claim 12 is specifically directed towards a system which has a supply of continuous web coupons and a downstream delivery system containing feed rolls and positioning rolls to burst and insert the coupon into the receiving container.

VI. Issues

The issues presented on appeal are:

A. Did the Examiner improperly reject claims 5-12 under 35 U.S.C. § 103(a) as unpatentable over Roetter *et al.*, U.S. Patent No. 4,261,497 in view of Lewis *et al.*, U.S. Patent No. 4,468,912?

VII. Grouping of Claims

For the rejection under 35 U.S.C. § 103(a), the rejected claims **do not** stand or fall together. Rather, appellants group the claims as follows:

Group 1 (method claims without a timing signal): Claims 5 and 7

Group 2 (method claims containing timing signal): Claims 6 and 8

Group 3 (apparatus claims): Claims 9-12

VIII. Argument

The Examiner rejected claims 5-12 under 35 U.S.C. § 103(a) as unpatentable over Roetter *et al.*, U.S. Patent No. 4,261,497 in view of Lewis *et al.*, U.S. Patent No. 4,468,912. Appellant respectfully submits this rejection was improper and not well taken.

Under 35 U.S.C. § 103(a), a prior art reference or references must establish a prima facie case of obviousness. *Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (Bd. Pat. App. & Int’f. 1992). Every element and limitation in the claims must be found in the objective teachings in the prior art or knowledge must be generally available to one of ordinary skill in the art that lead one to the claims invention. *Id.*

Appellant submits that the cited references do not establish a prima facie case of obviousness. Appellant submits that all of the pending claims are patentable over this combination of references for the following reasons: (1) there is no suggestion or motivation to combine the references to accomplish the Appellant’s invention; and (2) Roetter and Lewis, alone or in combination with other prior art, neither teach the Appellant’s invention nor solve the problem addressed by the Appellant’s invention.

A. There is No Motivation to Combine Roetter and Lewis to Accomplish the Appellant’s Invention

The Examiner maintains that both Roetter and Lewis are analogous “since both

references are feeding a continuous web of material and separating the material into individual sections.” (3/6/02 Office Action, p. 2). However, the “teachings of references can be combined only if there is some suggestion to do so.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). One cannot use hindsight to pick and choose isolated disclosures in the prior art. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Moreover, it is impermissible to use the claimed invention as a template to piece together the teachings of the prior art. *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). This is particularly true where the cited art is non-analogous art. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (such references are “insufficient to present a prima facie case of obviousness.”).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). Here, the Examiner offers no motivation or teaching to combine these references other than both separate individual sections from a continuous web. Roetter teaches a bursting means directed to the separation of computer printer paper, while Lewis teaches a cutting knife means for separating coupons. The Examiner has not advanced, nor is there in the references, any suggestion or motivation for one of ordinary skill in the art to combine two references which employ contradictory and mutually exclusive means for separating individual items from a continuous whole. There exists no suggestion in Roetter or Lewis to use a burster as a means for inserting coupons into packages. Moreover, there is no evidence that Roetter’s bursting mechanism would operate with the coupon applying means in Lewis. Roetter’s apparatus employs a bursting mechanism that continuously moves the forwardmost computer paper and bursts at regular intervals. By contrast, Lewis’ apparatus requires that the coupon on the web come to a stationary state for cutting and application on a

package.

Moreover, Roetter and Lewis are non-analogous art. Non-analogous art is “not available as a reference in evaluating the obviousness of appellants’ claimed invention.” *Ex parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd. Pat App. & Int’f. 1988). The combination of elements from non-analogous sources, in a manner that reconstructs the Applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. *Oetiker*, 977 F.2d at 1446. “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper.... Absent such reasons or incentives, the teachings of the references are not combinable.” *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int’f. 1987). This suggestion to combine is a “critical safeguard against hindsight analysis and rote application for the legal test of obviousness.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

The invention in Roetter is not directed towards the consumer packaging industry. The Examiner has not made a showing, as is his duty, that a person of ordinary skill, seeking to resolve the problem of efficiently and reliably inserting coupons into packages, would be reasonably expected or motivated to look to methods for bursting computer printer paper as an alternative to the mechanical cutting devices disclosed in Lewis. Absent such a showing, it is impermissible to reconstruct the Appellant’s invention through the use of hindsight.

Because there is no motivation to combine the prior art references, the obviousness rejection is improper towards all pending claims.

B. Roetter in View of Lewis Does Not Teach or Imply the Appellants Invention

Even if there was a motivation to combine, neither Roetter nor Lewis teach or imply to one of ordinary skill in the art how to solve the problem of positively and reliably

inserting one coupon into each of a plurality of containers. As previously discussed, one of the limitations of the prior art solved by the Appellant's novel invention is to provide an apparatus capable of detaching a single coupon from a continuous web at high speed and positively place a coupon in each of a plurality of containers moving at varying speeds. (Page 3, line 15 – Page 4, line 4).

Roetter, the first reference cited by the Examiner, discloses a bursting apparatus directed to separating continuous feed printer paper. Roetter alone does not provide any teaching or implication regarding placement of the separated paper. Lewis, the second reference cited by the Examiner, discloses an apparatus for placing coupons on top of cartons. In Lewis, the coupons are supplied in the form of a continuous web from which individual coupons are separated by the use of a mechanical blade which cuts the coupon from the web. The coupon is then moved and deposited on top of a carton.

Even if the references can be properly combined, Roetter in view of Lewis does not render obvious the pending claims because it does not teach or imply how to make the Appellant's invention. Even if it was obvious to try to combine the bursting mechanism of Roetter with the coupon apparatus of Lewis, the references would not teach one of ordinary skill in the art how to insert a coupon *into*, as opposed to on top of as taught by Lewis, a container as does Appellant's invention in claims 5, 7, 8, 10, and 12.

Even if Roetter and Lewis can be properly combined, it does not at all address the Appellant's invention as in claims 6 and 8. The Examiner states that Roetter, in view of Lewis, teaches to one of ordinary skill in the art at the time of the invention how to separate a desired product from a continuous web of material by bursting. (3/6/02 Office Action at p. 2-3).

However, with respect to claims 6 and 8, nothing in Roetter nor Lewis teach a solution or

address the problem of *when* to reliably insert a coupon into a container. Both the apparatuses disclosed in Roetter and Lewis operate to separate individual sections from a continuous web at regular intervals without regard for when to insert or deposit a coupon. Roetter employs a signal only to recognize that the next paper is properly advanced and ready to be burst. The signal is not linked in any way to the final disposition of the paper, and no concern is given for what happens to the separated paper after it has been burst. Lewis also does not have any timing signal and relies for proper coupon placement on regularity in spacing between containers and the separation of coupons at regular intervals to reliably and positively place one coupon onto each regularly spaced container.

Contrary to the Examiner's suggestion, the Appellant's invention is an improvement over the prior art which is not taught or implied by these references. Combining Roetter's burster as a means of separating a continuous web with the coupon application means of Lewis would not address the problem solved by Appellant's invention. With respect to claims 6 and 8, Appellant's invention employs a timing signal to link the bursting to the presence of a package to receive the coupon. Roetter's timing signal is directed only to sense the presence of the next coupon in a bursting position and results in continuous periodic bursting. Even if properly combinable, Roetter's separating means combined with Lewis' coupon application approach would attempt to place a coupon on the package at regular intervals regardless of whether a package was present to receive the coupon. This system would rely on regularity in spacing between containers and separation of coupons at regular intervals in order to reliably and positively place one coupon onto each container.

Appellant's invention, by contrast, addresses this inefficiency through the linking of the bursting operation to a timing signal related to the presence of a receiving container. In

other words, the Appellant's invention bursts a coupon only if a container is or will be present to receive the coupon. As a result, the Appellant's invention can be used to efficiently and positively place one coupon in each container even if each container is moving at a different speed or irregularly spaced at inconsistent intervals. This solution is not taught, implied, nor even addressed by Roetter or Lewis, alone or in combination.

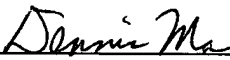
IX. CONCLUSION

For these reasons, the rejections under 35 U.S.C. § 103(a) should be withdrawn and each of the claims found allowable.

Respectfully submitted,

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Appendix A – Claims Pending on Appeal

5. A method for positioning coupons into food packaging, one at a time, each of said coupons having a leading edge and a trailing edge, said coupons being provided as a stream of coupons in a continuous web with a forwardmost coupon having its trailing edge connected to the leading edge of the next coupon in said continuous web by a weakened web portion extending transversely of said web, and each successive coupon being similarly connected in said web, said method comprising the steps of:

bursting said forwardmost coupon from the next coupon in said continuous web along said weakened web portion; and
placing said forwardmost coupon into said food packaging.

6. A method for positioning coupons at a predetermined location, one at a time, each of said coupons having a leading edge and a trailing edge, said coupons being provided as a stream of coupons in a continuous web with a forwardmost coupon having its trailing edge connected to the leading edge of the next coupon in said continuous web by a weakened web portion extending transversely of said web, and each successive coupon being similarly connected in said web, said method comprising the steps of:

providing a signal related to the time at which said forwardmost coupon is to be positioned at said predetermined location;

bursting said forwardmost coupon from the next coupon in said continuous web along said weakened web portion; and

placing said forwardmost coupon at said predetermined location in response at least in part to said signal.

7. A method of delivering coupons to containers at a predetermined point of insertion, one at a time, the coupons being provided in a continuous web wherein a trailing edge of a forwardmost coupon is detachably connected to a leading edge of a successive coupon by a weakened separable portion there between and wherein each coupon after the successive coupon is similarly connected in the web, the method thereby of manufacturing containers having coupons therein and comprising the steps of:

providing a coupon separation and delivery subassembly between said continuous web and said predetermined point of insertion, said subassembly including feed rolls and positioning rolls, said positioning rolls disposed downstream of said feed rolls;

advancing said continuous web of coupons utilizing said feed rolls; and

separating said forwardmost coupon from said successive coupon and delivering said forwardmost coupon to one of said containers at said predetermined point of insertion.

8. A method of delivering coupons to containers at a predetermined point of insertion, one at a time, the coupons being provided in a continuous web wherein a trailing edge of a forwardmost coupon is detachably connected to a leading edge of a successive coupon by a weakened separable portion there between and wherein each coupon after the successive coupon is similarly connected in the web, the method thereby manufacturing containers having coupons therein and comprising the steps of:

providing a signal pertaining to when to insert said forwardmost coupon into one of said containers at said predetermined point of insertion;

providing a coupon separation and delivery subassembly between said continuous web and said predetermined point of insertion, said subassembly including feed rolls and positioning rolls, said positioning rolls disposed downstream of said feed rolls;

advancing said continuous web utilizing said feed rolls; and

separating said forwardmost coupon from said successive coupon in response at least in part to said signal and delivering said forwardmost coupon to one of said containers at said predetermined point of insertion.

9. Apparatus for positioning coupons into containers, one at a time, at a predetermined location, each of said coupons having a leading edge and a trailing edge, said coupons being provided as a stream of coupons arranged in a continuous web of successive coupons with a forwardmost coupon having its trailing edge connected to the leading edge of the next coupon in said continuous web by a weakened web portion extending transversely of said web, and each successive coupon being similarly connected in said web, said apparatus comprising:

support apparatus;

positioning rolls rotatably mounted relative to said support apparatus and defining a bight to receive the leading edge of said forwardmost coupon;

feed rolls rotatably mounted relative to said support apparatus, said feed rolls being oriented to direct said leading edge of said forwardmost coupon into said bight; and

feed drive to drive at least one of said feed rolls to move said leading edge of said forwardmost coupon toward said bight, bursting said forwardmost coupon and moving said forwardmost coupon toward said container at said predetermined location.

10. Apparatus for positioning coupons into containers at a point of insertion, said coupons provided in a continuous web wherein the trailing edge of a first coupon is connected to the leading edge of a successive coupon with a separable portion, said apparatus comprising:

coupon advancing apparatus including feed rolls and feed drive to rotate said feed rolls, said feed rolls engaging said continuous web to advance said first coupon of said continuous web to a delivery position; and

delivery apparatus, including positioning rolls for engaging said first coupon and positioning drive to rotate said positioning rolls to separate the trailing edge of said first coupon from the leading edge of said successive coupon along said separable portion, to deliver said first coupon into at least one of said containers at said point of insertion.

11. An apparatus for delivering coupons, one at a time, to containers at a predetermined location, said coupons being provided in a continuous web wherein a trailing edge of a forwardmost coupon is detachably connected to a leading edge of a successive coupon by a weakened separable portion disposed therebetween, each coupon following said successive coupon being similarly connected in said web, said apparatus comprising:

opposed positioning rolls rotatably mounted and defining a bight for receiving the leading edge of said forwardmost coupon;

opposed feed rolls disposed upstream from said positioning rolls, said feed rolls rotatably mounted and oriented for directing the leading edge of said forwardmost coupon into said bight of said positioning rolls;

a positioning drive mechanism coupled to at least one of said positioning rolls for driving

said positioning rolls and moving said forwardmost coupon; and

a feed drive mechanism coupled to at least one of said feed rolls for driving said feed rolls and moving the leading edge of said forwardmost coupon toward said bight of said positioning rolls, separating the trailing edge of said forwardmost coupon from the leading edge of said successive coupon, and delivering the separated forwardmost coupon to said container at said predetermined location.

12. A coupon processing system for delivering coupons to food packaging at a predetermined point of insertion, said coupon processing system comprising:

a coupon supply including a continuous web of coupons wherein a trailing edge of a first coupon is connected to a leading edge of a successive coupon by a separable portion there between, each coupon thereafter being similarly connected in said continuous web;

a coupon delivery assembly disposed downstream of said coupon supply, said coupon delivery assembly including a set of feed rolls and a set of positioning rolls disposed downstream of said feed rolls, and said coupon delivery system separating said first coupon from said successive coupon and insertion of said first coupon into said food package at said predetermined point of insertion.